

### **Remarks/Arguments**

Reconsideration of the above-identified application in view of the present amendment is respectfully requested.

The applicants acknowledge, with appreciation, the indication of the allowability of claims 4-11 and 20-27. Claims 4 and 20 are rewritten in independent form, including all of the limitations of their respective intervening claims. Claim 13 is amended to overcome the objection set forth within the Office action.

Claims 2, 3, 15, 16, 18, and 19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is respectfully traversed in view of the following comments. The Examiner contends that claims 2, 3, 25, 16, 18, and 19 are indefinite for referring to a time interval without specifying that said time interval is greater than zero. Applicants respectfully disagree. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *See* MPEP § 213.02. It is submitted that the methods and devices of claims 2, 15, and 18 could also include the case of a zero time interval. For example, the claimed process and device would operate with an immediate mode change after each contact. With regards to claims 3, 16, and 19, one of ordinary skill in the art would have understood that the time interval is greater than zero, as a time interval shorter than zero would not make sense.

Claims 1-3, 12-14, 15, 17-19, and 29 were rejected under 35 U.S.C. 102(b) as being anticipated by Glasson (US 5,781,450). This rejection is respectfully traversed in view of the following comments. Glasson is directed to a three-dimensional coordinate measuring machine. In contrast, independent claims 1, 14, 15, 17, and 29 are directed to height measuring columns. During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. *See, e.g., In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). A height measuring column is much simpler than a three-dimensional coordinate measuring machine. The height measuring column has one measurement axis, the Z axis, and the measurement requires that a user moves a piece to be measured in the X and Y directions by hand, as the entity of X and Y displacements are not accessible to the height

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measuring column. The algorithms disclosed in Glasson all require analyzing three-dimensional movement in X, Y, and Z, which could not be applied to a height measuring column of the present invention. Accordingly, because Glasson does not disclose each and every element set forth in claims 1-3, 12-14, 15, 17-19, and 29, Glasson does not anticipate such claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

Claim 28 was rejected under 35 U.S.C. 103(a) as being unpatentable over Glasson (US 5,781,450) in view of Tsukamoto et al. (US 5,991,706). Claim 28 depends from independent claim 17, which is believed to be allowable over Glasson for at least the reasons cited above. Tsukamoto et al. does not make up for the aforementioned deficiencies of Glasson. Accordingly, the combination of Glasson and Tsukamoto et al. does not make obvious claim 28.

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance and allowance for the above-identified application is respectfully requested.

Six additional claims 38-43 have been added in this amendment. A check for \$108 to cover these claims is enclosed. If there are any additional fees required by the foregoing Amendment, please charge the same to our Deposit Account No. 16-0820, our Order No. 34119.

Respectfully submitted,  
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